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Woodcock Washburn LLP Cira Centre, 12th Floor 2929 Arch Street Philadelphia, PA 19104-2891			PRICE, RICHARD THOMAS JR	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAREN HOGAN

Appeal 2009-005707
Application 10/667,680
Technology Center 3600

Decided: April 21, 2010

Before: JENNIFER D. BAHR, STEVEN D.A. McCARTHY, and KEN B.
BARRETT, *Administrative Patent Judges.*

BAHR, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Karen Hogan (Appellant) appeals under 35 U.S.C. § 134 (2002) from the Examiner's decision rejecting claims 1-29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; claims 1-4, 6, and 9-11 under 35 U.S.C. § 102(b) as being anticipated by Taunton (US 2,778,173, issued Jan. 22, 1957); claims 14-18, 20, 21, and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Taunton; and claims 5, 7, 8, 19, 21-23, and 27-30 under 35 U.S.C. § 103(a) as being unpatentable over Taunton and Logan (US 6,212,716 B1, issued Apr. 10, 2001). We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

The Invention

Appellant's claimed invention is directed to "an apparatus and method for selectively or contemporaneously tenderizing and marinating meats or other selected food items." Spec. 2:6-9.

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. An apparatus and method for selectively or contemporaneously tenderizing and marinating meats or other selected food items, said apparatus comprising:

 a bag comprising a mechanical tenderizing surface disposed therewithin,

 wherein said mechanical tenderizing surface comprises a plurality of protuberances, and

 wherein said protuberances are sufficiently rigid to at least one of deform and penetrate an external surface of the meat or other selected food item disposed within said bag, and to thereby tenderize same.

SUMMARY OF DECISION

We AFFIRM-IN-PART.

OPINION

The Written Description Rejection

The Issue

The issue presented is whether Appellant's Specification provides written description support for the claim limitation that the "protuberances are sufficiently rigid to at least one of deform and penetrate an external surface of the meat or other selected food item." *See* Ans. 3.

Discussion

The language cited by the Examiner as lacking written description support is contained in independent claims 1 and 15, but is not contained in independent claim 25 and claims 26-29 depending from claim 25. Thus, we reverse the rejection as to claims 25-29.

Appellant's Specification, as submitted on the filing date of the application, discloses that "[t]enderizing teeth 40 are preferably substantially 'blunted' pyramidal-shaped, as is known with the art, yet possess a sufficient angular dimension to effectively pierce the meat M or other food item placed within bag 20." Spec. 16:16-19. Appellant's Specification, as submitted on the filing date of the application, also discloses that the sealed bag 20 is repeatedly struck "to forcefully drive the plurality of tenderizing teeth 40 into meat M, and thus tenderize same." Spec. 17:18-22. These disclosures clearly convey that the teeth (protuberances) of Appellant's invention must have the requisite characteristics, including the requisite rigidity and shape, to pierce, or penetrate, thus also deforming, in the sense

of disturbing or marring¹, an external surface of the meat when the bag is repeatedly struck. These disclosures therefore satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. *See Ariad Pharm., Inc. v. Eli Lilly and Co.*, --- F.3d ----, 2010 WL 1007369, at *12 (Fed. Cir. 2010) (“[T]he test for sufficiency [in complying with the written description requirement] is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.”). The written description requirement does not demand that “the specification recite the claimed invention *in haec verba*.” *Ariad*, 2010 WL 1007369 at *13. We reverse the rejection as to claims 1-24.

The Anticipation Rejection

The Issue

Appellant argues that Taunton’s projections 12, on which the Examiner reads the “protuberances” of Appellant’s claim 1, are nothing more than corrugations or depressions in the flexible film that are “incapable of performing the claimed food tenderizing function,” and thus cannot reasonably be considered to anticipate the claimed protuberances of Appellant’s claim 1. App. Br. 6. Appellant does not present any separate arguments for claims 2-4, 6, and 9-11 apart from those asserted against the rejection of claim 1. Thus, claims 2-4, 6, and 9-11 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

¹ The ordinary and customary usage of “deform” as “impl[ying] a marring of form, appearance, or character, as if by pressure or stress” (*Webster’s New World Dictionary* 371 (David B. Guralnik ed., 2nd Coll. Ed., Simon & Schuster, Inc. 1984)) is consistent with the description of the impact of the protrusions on the meat or other food item in Appellant’s Specification.

Accordingly, the issue presented is whether Taunton's projections 12 are capable of either deforming or penetrating an external surface of a meat or other selected food item disposed within the bag to thereby tenderize the meat or other selected food item.

Discussion

We find that Taunton describes a package formed from an airtight, flexible film material folded over on itself and sealed on three sides, provided with an exhausting hole 9 and projections 12. Col. 3, ll. 32-60. The projections are designed to prevent the inner faces of the film material from adhering to each other during the process of evacuation through exhausting hole 9, especially in the vicinity of the exhausting hole. Col. 1, ll. 65-71. Taunton's projections 12 are provided on the inner surface of the film, or in a strip inserted between the two layers of film, in at least the vicinity of the exhausting hole 9, but may extend over the entire area of the film. Col. 3, ll. 51-60, col. 4, ll. 3-21. Taunton's projections 12 serve to maintain spacing between the upper and lower layers of the film package during evacuation, thereby providing passages between the projections for air being exhausted from the package. Col. 2, l. 61 to col. 3, l. 6. Thus, Taunton's projections 12 have sufficient structural integrity to withstand the vacuum forces drawing the layers of the package together. Taunton's projections may be in the form of "pyramidal protuberances." Col. 2, ll. 49-50; col. 4, ll. 28-29; figs. 9-10.

Taunton's disclosure is directed to producing an airtight package by evacuating the air from within the package. Col. 1, ll. 16-18. Taunton does not describe marinating or tenderizing food products within the airtight

package, or explicitly characterize the projections 12 as forming a tenderizing surface.

“A patent applicant is free to recite features of an apparatus either structurally or functionally Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk.” *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). When the PTO has reason to believe that a functional limitation asserted to be critical may in fact be an inherent characteristic of the prior art, it possesses the authority to shift the burden of proof to the applicant or patent owner to prove otherwise. *Id.*; *see also In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). Whether the rejection is based on inherency under 35 U.S.C. § 102 or on obviousness under 35 U.S.C. § 103, jointly or alternatively, “the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.” *Best*, 562 F.2d at 1255.

The Examiner found that “Taunton clearly shows a plurality of protuberances, whose shape(s) are similar to the shapes as disclosed by Applicant.” Ans. 6. Appellant has not contested that finding. Indeed, as noted in our findings above, both Appellant (Spec. 16:17) and Taunton (col. 2, ll. 49-50; col. 4, ll. 28-29; figs. 9-10) disclose pyramidal protuberances. Moreover, as additionally noted in our findings above, Taunton’s projections 12 have sufficient structural integrity to withstand the vacuum forces drawing the layers of the package together. Accordingly, we are satisfied that the Examiner has presented sufficient evidence to give the PTO reason to believe that Taunton’s projections 12 are capable of either deforming or penetrating an external surface of a meat or other *unspecified* selected food

item disposed within the bag to thereby tenderize the meat or other *unspecified* selected food item, thereby shifting the burden of proof to Appellant to prove otherwise. Appellant has proffered no evidence or convincing argument to satisfy that burden.

For the above reasons, we sustain the rejection of claim 1 and claims 2-4, 6, and 9-11, which fall with claim 1, as being anticipated by Taunton.

The Obviousness Rejections

Claims 5, 7, and 8

In contesting the rejection of claims 5, 7, and 8 as being unpatentable over Taunton and Logan, Appellant simply relies on the argument asserted against the rejection of claim 1. App. Br. 6. For the same reasons set forth in our discussion of the anticipation rejection above, this argument is unconvincing with respect to the rejections of claims 5, 7, and 8. Accordingly, we also sustain the rejection of claims 5, 7, and 8 as being anticipated by Taunton and Logan.

Claims 15-18, 20, and 21

In contesting the rejection of claims 15-18, 20, and 21 as being unpatentable over Taunton, Appellant groups all the claims together. Thus, claims 16-18, 20, and 21 stand or fall with claim 15. 37 C.F.R. § 41.37(c)(1)(vii). We note that claim 15, which recites “[a]n apparatus and method for ...,” contains no method steps and is limited to an apparatus.

Appellant argues that the Examiner has not established which elements of the claimed invention are taught by Taunton, which elements are not taught by Taunton, and how one of ordinary skill in the art would modify Taunton to arrive at the claimed invention. App. Br. 8. While we agree with Appellant that the Examiner’s articulation of the rejection of these claims is

not the model of clarity², the Examiner has made findings as to structure in Taunton that satisfies each and every element recited in claims 15-18, 20, and 21.³ See Ans. 3-4 and 5. Aside from the argument that Taunton does not teach the claimed tenderizing surfaces having rigid protuberances as called for in claim 15 (App. Br. 7), Appellant has not contested any of the Examiner's findings with respect to the limitations of these claims.

Appellant's argument that Taunton does not teach the claimed tenderizing surfaces having rigid protuberances as called for in claim 15 is unconvincing for the reasons set forth above in our discussion of the anticipation rejection. Specifically, for the reasons discussed above, we are satisfied that the Examiner has presented sufficient evidence to give the PTO reason to believe that Taunton's projections 12 have sufficient rigidity to either deform or penetrate an external surface of a meat or other *unspecified* selected food item disposed within the bag to thereby tenderize the meat or other *unspecified* selected food item, thereby shifting the burden of proof to Appellant to prove otherwise. Appellant has proffered no evidence or convincing argument to satisfy that burden.

Accordingly, we sustain the Examiner's rejection of claims 15-18, 20, and 21 as being unpatentable over Taunton.

² The Examiner inadvertently refers to claims 2, 3, and 9-11, rather than to claims 16-8, 20, and 21. Ans. 5.

³ A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103(a), as "anticipation is the epitome of obviousness." *In re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2002) (quoting *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)); *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982).

Claims 19 and 21-23

In contesting the rejection of claims 19 and 21-23 as being unpatentable over Taunton and Logan, Appellant merely relies on the argument asserted with respect to claim 15 (App. Br. 7), which, for the reasons discussed above, is unconvincing. The argument is likewise unconvincing with respect to claims 19 and 21-23. Accordingly, we also sustain the rejection of claims 19 and 21-23 as being unpatentable over Taunton and Logan.

Claims 14 and 24

Claims 14 and 24 require a stoppered drainage spout carried by the bag. In rejecting these claims as being unpatentable over Taunton, the Examiner found that “Taunton does not discuss the use of a drain spout attached to the bag.” Ans. 5. The Examiner concluded, however, that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the bag of Taunton with a drainage spout” to allow “a user to remove unwanted liquids from the interior of the bag without opening the bag completely.” *Id.*

Appellant argues that the Examiner has failed to establish that the claimed stoppered drainage spout is taught in the prior art, and thus has relied on Appellant’s teaching of a stoppered drainage spout in reaching a conclusion of obviousness. App. Br. 8. Thus, according to Appellant, the Examiner has relied on impermissible hindsight reconstruction in rejecting the claims. *Id.*

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be “some articulated reasoning with some rational underpinning.” *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir.

2006), *cited with approval in KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d, 1071, 1073 (Fed. Cir. 1988).

The Examiner's rejection of claims 14 and 24 is deficient in two respects. First, as pointed out by Appellant, the Examiner has made no explicit finding that the use of stoppered drainage spouts was known in the art at the time of Appellant's invention. Second, even accepting that the use of stoppered drainage spouts was known in the art at the time of Appellant's invention, the Examiner has failed to establish that the proposed reason for modifying Taunton to provide one has rational underpinning. Specifically, the Examiner has not cogently explained why a person of ordinary skill in the art would have been prompted to provide a stoppered drainage spout to remove unwanted liquids from Taunton's airtight package. Any unwanted liquids seemingly could be removed from the package through the exhaust hole 9.

For the above reasons, we reverse the rejection of claims 14 and 24 as being unpatentable over Taunton.

Claims 25-30

Appellant argues that the Examiner has not made any findings with respect to which elements of claim 25 are satisfied by Taunton, and which claim elements are missing, or explained how one of ordinary skill in the art would have modified Taunton's package to arrive at the subject matter of

claim 25. App. Br. 8. We agree. The Examiner has not specifically addressed the limitations of claim 25. The Examiner has made a finding, in addressing claim 15, that “it is notoriously well-known in the art to place food items in a marinade bag and to tenderize the food items by hitting the bag to one of ordinary skill in the art at the time the invention was made.” Ans. 5. To the extent that this finding is intended to address step c of claim 25, it is still insufficient to establish that the subject matter of claim 25 would have been obvious. First, even accepting that the Examiner’s finding is correct, the Examiner has not articulated any reason why it would have been obvious to a person of ordinary skill in the art to apply this tenderizing technique to the airtight package of Taunton, which is not described as being a marinade bag, or as containing marinade. *See KSR*, 550 U.S. at 418 (a conclusion of obviousness must be supported by explicit findings and analysis establishing an apparent reason to combine the known elements in the manner required in the claim at issue). Moreover, Appellant has explicitly contested the Examiner’s finding, argued that Appellant is not aware of any such prior methodology, and requested that the Examiner produce evidence to support this finding. App. Br. 7. The Examiner has not responded to that challenge. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

For the above reasons, the Examiner has fallen short in establishing that Taunton renders obvious the subject matter of claim 25 and claim 26,

which depends from claim 25. Thus, we reverse the rejection of claims 25 and 26 as being unpatentable over Taunton.

The Examiner has not relied on Logan for any teaching that might have provided a person of ordinary skill in the art with a reason to modify Taunton's process of producing an airtight package by performing a step of deforming or penetrating an external surface of the food item placed in the package to tenderize the food item, as called for in claim 25, from which claims 27-30 depend. Therefore, the Examiner has also failed to establish that Taunton and Logan render obvious the subject matter of these claims. We reverse the rejection of claims 27-30 as being unpatentable over Taunton and Logan.

DECISION

The Examiner's decision is affirmed as to claims 1-11 and 15-23, and reversed as to claims 12-14 and 24-30.

AFFIRMED-IN-PART

hh

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